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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,702	08/07/2001	Fumitake Yodo		1747

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EXAMINER
FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,702	Applicant(s) Fumitake Yodo
	Examiner Andrew J. Fischer	Art Unit 2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *8 and 9* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *8 and 9* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. *09/600,509*.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Acknowledgments

1. The amendment filed August 7, 2001 (Paper No. 2) is acknowledged. Accordingly, claims 8 and 9 remain pending.

Information Disclosure Statement

2. The references considered in the parent Application have been considered. However, unless the references are stated on a separate PTO-1449 or cited again by the Examiner, they will not be printed on the face of any patent issuing from this application.

Specification

3. The Examiner notes this is a divisional application. The specification should therefore be amended to include only subject matter related to the claimed invention or needed to understand the claimed invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 8 recites the limitation "the distributed information" in line 8. There is insufficient antecedent basis for this limitation in the claim.

b. Claim 9 recites the limitation "the distributed information" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 8 and 9, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Ushiki et. al. (U.S. 5,438,356). Ushiki et. al. discloses the following: a terminal device (a personal computer) first memory means (a particular address in the memory); a second memory means (a second particular address in the memory); first control means (the CPU); a second control means (4) an accounting center (10) with its computer

8. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and

define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)("[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art."). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).[1]

However, if Applicant does desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) to expressly indicate the claim limitation at issue[2] and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or

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[1] It is the Examiner's position that "plain meaning" and "ordinary and accustom meaning" are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) ("[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . . .").

[2] "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, ("[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must 'clearly set forth' or 'clearly redefine' a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term").[3] The Examiner cautions that no new matter is allowed.

Failure by Applicant to address this issue in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant to, at least initially, give all claim limitations their ordinary and accustom meaning. Applicant is reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that claim element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

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[3] See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), ("[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]"); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) ("Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention."). See also MPEP §2111.02, subsection titled "Applicant May Be Own Lexicographer" and MPEP §2173.05(a) titled "New Terminology."

9. Although Applicant uses "means for" in the claims (e.g. in claim 8, "means for storing accounting point information"), it is the Examiner's position that the "means for" phrases do not invoke 35 U.S.C. 112 6th paragraph. If Applicant concurs, the Examiner respectfully requests Applicant to either amend the claims to remove all instances of "means for" from the claims, or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.

Alternatively, if Applicant desires to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant to expressly state his desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the "means for" phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*.[4]

Failure by Applicant to address the 35 U.S.C. 112 6th paragraph issues in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6th paragraph.

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[4] Federal Register Vol 65, No 120, June 21, 2000.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Iwamura (U.S. 6,144,946); Wexler (U.S. 5,960,409); Iwamura (U.S. 5,937,395); Brown (U.S. 5,875,435); Manduely (U.S. 5,812,536); and Anno et. al. (U.S. 5,371,680).

11. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

ANDREW J. FISCHER
PATENT EXAMINER
4/21/02

4/22/02
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AJF
April 21, 2002